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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,536

08/16/2006

Klaus Abraham-Fuchs

32860-001075/US

8473

30596

7590

12/23/2009

HARNESS, DICKEY & PIERCE, P.L.C.

P.O.BOX 8910

RESTON, VA 20195

EXAMINER

WINSTON III, EDWARD B

ART UNIT

PAPER NUMBER

3686

MAIL DATE

DELIVERY MODE

12/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,536	Applicant(s) ABRAHAM-FUCHS ET AL.	
	Examiner EDWARD WINSTON	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>August 16, 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on August 16, 2006.
2. Claim(s) 1-30 are currently pending and have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an

act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, “Process claim that recites fundamental principle, and that otherwise fails ‘machine-or-transformation’ test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’” (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)). Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test.

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495).

Claims 1-30, as recited, is directed toward a method for (the quality evaluation of electronically stored, knowledge data) comprising the steps of (storing, correlating, accessing). Please note that “computerized” in the preamble does not qualify as sufficient structure when (1) a computer, (2) computer-program product having instructions tangibly embodied thereon, when executed by a processor resulting in the recited steps, (3) network, etc. for example, are never recited in the body of the claim. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus, i.e. computer, network, computer-readable medium, etc., that accomplishes the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. As currently written the steps recited in claims 1-30 may be performed by hand or mentally and are therefore not sufficiently tied to another statutory class. It is noted that computer is used to display however there is no indication that any of the other steps are performed by a computer and/or data received via a network, etc.

Claims 1-30 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claim 1-30 are non-statutory under § 101.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Sabol et al. (US 2004/0122719).

CLAIM 1.

Sabol et al. teach(s) a method for the quality evaluation of electronically stored, knowledge data the method comprising:

- storing knowledge data in a database; and correlating quality data with the knowledge data stored in the database, a user at least one of storing the quality data in the database at least one of during and after access to the knowledge data, and storing result data (see at least Paragraph 0004, i.e. prescribable data) from the application of knowledge data in a result database and correlating quality data with the result data, the application of the knowledge data being automatically generated and stored in the database and, upon the user accessing the knowledge data, the quality data automatically being provided to the user. (see at least Figure 1, Paragraph 0061 and 0079)

CLAIM 2.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein the user applies the knowledge data, and quality data correlated with the results of the application are stored in the database (see at least Figure 1, Paragraph 0061 and

0079).

CLAIM 3.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein quality criteria correlated with the knowledge data are stored in the database (see at least Paragraph 0079 and 0297).

CLAIM 4.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein an identification of the user is assigned to the quality data and stored in the database (see at least Paragraph 0335 and 0342).

CLAIM 5.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein the user determines quality data with a time delay after application of the knowledge data, and the user is automatically requested to store the quality data in the database (see at least Paragraph 0072, wherein archive module 84 permits the raw, semi-processed, and processed data to be stored either locally at the acquisition system or

resource, or remote therefrom, such as in a database, repository, archiving system (e.g. PACS), and so forth.)

Examiner notes that Paragraph [0032] states that the user determines quality data with a time delay.

CLAIM 6.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein the result database is at least one of an electronic patient database and an electronic hospital information system, and patient outcome data are stored as result data in the result database (see at least Figure 1, Paragraph 0061 and 0079).

CLAIM 7.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein quality data are determined from the result database according to quality criteria, and the quality data are stored in the database (see at least Figure 1, Paragraph 0061 and 0079).

CLAIM 8.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein quality data are determined from the result database according to the quality criteria with a time delay, and an access path to the result database is assigned to the quality criterion (see at least Figure 1, Paragraph 0061, 0072 and 0079).

CLAIM 9.

Sabol et al. further teach(s) a method claimed in claim 8:

- wherein a result database denoted by the access path is automatically checked for the presence of the result data assigned to the quality criteria (analysis of data), and when the result data are present, quality data are generated from them according to the quality criteria and stored in the database.

(see at least Paragraph 0079)

CLAIM 10.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein a quality measure is determined as quality data, and a determination instruction for the quality measure is stored in the database.

(see at least Paragraph 0079)

CLAIM 11.

Sabol et al. further teach(s) a method claimed in claim 10:

- wherein the determination instruction is at least one of a formula and an expert rule (see at least Paragraph 0408).

CLAIM 12.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein different users use the same knowledge data and quality data assigned to the users are determined therefrom, and a ranking of the success rate of the users is calculated from the quality data (see at least Paragraph 0332 and 0417).

CLAIM 13.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein comparable knowledge data are used and quality data assigned to the knowledge data are determined therefrom, and a ranking of the quality of the knowledge data is calculated from the quality data (see at least Paragraph 0332 and 0417).

CLAIM 14.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein knowledge data are released for use by the user only after the user has assigned their identification to the knowledge data or an access path for result data from the use of the knowledge data (see at least Paragraph 0342). (see at least Figure 1-3, Paragraph 0061, 0079 and 0342)

CLAIM 15.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein knowledge data are released for use by the user only after the user has paid a fee, and the user receives a reimbursement of the fee after storing the quality data (see at least Paragraph 0441).

CLAIM 16.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein the use of the knowledge data is chargeable to the user, and the quality data, but not the assigned knowledge data, is freely viewable by the user (see at least Paragraph

0441).

CLAIM 17.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein the date of the creation of the quality data is stored in the database together with the quality data (see at least Paragraph 0392).

CLAIM 18.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein at least one of medical treatment recommendations advice is stored as knowledge data (see at least Paragraph 0326).

CLAIM 19.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein medical guidelines are stored as knowledge data (see at least Figure 1-3, Paragraph 0061 and 0079).

CLAIMS 20.-21. (canceled)

CLAIM 22.

Sabol et al. further teach(s) a method claimed in claim 2:

- wherein quality criteria correlated with the knowledge data are stored in the database (see at least Figure 1-3, Paragraph 0061 and 0079).

CLAIM 23.

Sabol et al. further teach(s) a method claimed in claim 6:

- wherein quality data are determined from the result database according to quality criteria, and the quality data are stored in the database (see at least Figure 1-3, Paragraph 0061 and 0079).

CLAIM 24.

Sabol et al. further teach(s) a method claimed in claim 6:

- wherein quality data are determined from the result database according to the quality criteria with a time delay, and an access path to the result database is assigned to the

quality criterion (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

CLAIM 25.

Sabol et al. further teach(s) a method claimed in claim 7:

- wherein quality data are determined from the result database according to the quality criteria with a time delay, and an access path to the result database is assigned to the quality criterion (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

CLAIM 26.

Sabol et al. further teach(s) a method claimed in claim 23:

- wherein quality data are determined from the result database according to the quality criteria with a time delay, and an access path to the result database is assigned to the quality criterion (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

CLAIM 27.

Sabol et al. further teach(s) a method claimed in claim 26:

- wherein a result database denoted by the access path is automatically checked for the presence of the result data assigned to the quality criteria, and when the result data are

present, quality data are generated from them according to the quality criteria and stored in the database (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

CLAIM 28.

Sabol et al. further teach(s) a method claimed in claim 1:

- wherein the knowledge data is medical knowledge data (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

CLAIM 29.

Sabol et al. teach(s) a method for quality evaluation of electronically stored knowledge data the method comprising:

- storing knowledge data in a database; correlating quality data with the knowledge data stored in the database; and automatically providing, upon the user accessing the knowledge data, the quality data to the user (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

CLAIM 30.

Sabol et al. further teach(s) a method claimed in claim 29:

- wherein the knowledge data is medical knowledge data (see at least Figure 1-3, Paragraph 0061, 0079 and 0342).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD WINSTON whose telephone number is (571) 270-7780. The examiner can normally be reached on MONDAY-THURDAY; 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/E. W./
Examiner, Art Unit 3686
December 8, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686